

# THE DECISIONS

OF

THE SUPREME COURT OF THE UNITED STATES

AT

JANUARY TERM 1829.

---

ABRAHAM L. PENNOCK & JAMES SELLERS, PLAINTIFFS IN ERROR  
*vs.* ADAM DIALOGUE.

The record contains, embodied in the bill of exceptions, the whole of the testimony and evidence offered at the trial of the cause by each party in support of the issue. It is very voluminous, and as no exception was taken to its competency or sufficiency, either generally or for any particular purpose; it is not properly before this court for consideration, and forms an expensive and unnecessary burthen upon the record. This Court has had occasion, in many cases, to express its regret on account of irregular proceedings of this nature. There was not the slightest necessity of putting any portion of the evidence in this case upon the record; since the opinion of the court, delivered to the jury, presented a general principle of law; and the application of the evidence to it was left to the jury. [15]

It is no ground of reversal, that the court below omitted to give directions to the jury upon any points of law which might arise in the cause, where it was not requested by either party at the trial. It is sufficient for us, that the court has given no erroneous directions. [16]

If either party considers any point presented by the evidence, omitted in the charge of the court, it is competent for such party to require an opinion from the court upon that point. The court cannot be presumed to do more in ordinary cases, than to express its opinion upon questions, which the parties themselves have raised on the trial. [16]

It has not been, and indeed it cannot be denied, that an inventor may abandon

VOL. II.—A

[Pennock & Sellers vs. Dialogue.]

his invention, and surrender or dedicate it to the public. This inchoate right, thus gone, cannot afterwards be resumed at his pleasure; for when gifts are once made to the public in this way, they become absolute. The question which generally arises on trials is a question of fact, rather than of law; whether the acts or acquiescence of the party, furnish, in the given case, satisfactory proof of an abandonment, or dedication of the invention to the public. [16]

It is obvious, that many of the provisions of our patent act, are derived from the principles and practice which have prevailed in the construction of the law of England in relation to patents. [18]

Where English statutes, such for instance as the statute of frauds, and the statute of limitations, have been adopted into our own legislation; the known and settled construction of those statutes by courts of law, has been considered as silently incorporated into the acts; or has been received with all the weight of authority. This is not the case with the English statute of monopolies, which contains an exception, on which the grants of patents for inventions have issued in that country. The language of that clause in the statute is not identical with the patent law of the United States; but the construction of it adopted by the English courts, and the principles and practice which have long regulated the grants of their patents; as they must have been known, and are tacitly referred to in some of the provisions of our own statute, afford materials to illustrate it. [18]

The true meaning of the words of the patent law, "not known or used before the application;" is, not known or used *by the public*, before the application. [19]

If an inventor should be permitted to hold back from the knowledge of the public the secrets of his invention; if he should, for a long period of years, retain the monopoly, and make and sell his invention publicly; and thus gather the whole profits of it, relying upon his superior skill and knowledge of the structure; and then, and then only, when the danger of competition should force him to procure the exclusive right, he should be allowed to take out a patent, and thus exclude the public from any further use, than what should be derived under it, during his fourteen years; it would materially retard the progress of science and the useful arts; and give a premium to those who should be least prompt to communicate their discoveries. [19]

If an invention is used by the public, with the consent of the inventor, at the time of his application for a patent; how can the Court say, that his case is nevertheless such as the act was intended to protect? If such a public use is not a use within the meaning of the statute; how can the Court extract the case from its operation, and support a patent, when the suggestions of the patentee were not true; and the conditions, on which alone the grant was authorised, do not exist? [21]

The true construction of the patent law is, that the first inventor cannot acquire a good title to a patent, if he suffers the thing invented to go into public use, or to be publicly sold for use, before he makes application for a patent. This voluntary act, or acquiescence in the public sale or use, is an abandonment of his right; or rather, creates a disability to comply with the terms and conditions of the law; on which alone the secretary of state is authorised to grant him a patent. [23]

[Pennock & Sellers vs. Dialogue.]

THIS case was brought before the Court, on a writ of error to the circuit court for the eastern district of Pennsylvania.

In that court, the plaintiffs in error had instituted their suit against the defendants, for an infringement of a patent right, for "an improvement in the art of making tubes or hose for conveying air, water, and other fluids." The invention claimed by the patentees, was in the mode of making the hose so that the parts so joined together would be tight, and as capable of resisting the pressure as any other part of the machine.

The bill of exceptions, which came up with the record, contained the whole evidence given in the trial of the cause in the circuit court. The invention, for which the patent right was claimed, was completed in 1811; and the letters patent were obtained in 1818. In this interval, upwards of *thirteen thousand feet of hose*, constructed according to the invention of the patentees, had been made and sold in the city of Philadelphia. One Samuel Jenkins, by the permission of, and under an agreement between the plaintiffs as to the price; had made and sold the hose invented by the plaintiffs, and supplied several hose companies in the city of Philadelphia with the same. Jenkins, during much of the time, was in the service of the plaintiffs, and had been instructed by them in the art of making the hose. There was no positive evidence, that the agreement between Jenkins and the plaintiffs in error was known to, or concealed from the public. The plaintiffs, on the trial, did not allege or offer evidence to prove that they had delayed making application for a patent, for the purpose of improving their invention; or that from 1811 to 1818, any important modifications or alterations had been made in their riveted hose. The plaintiffs claimed before the jury, that all the hose which had been made and sold to the public, prior to their patent, had been constructed and vended by Jenkins under their permission.

Upon the whole evidence in the case, the circuit court charged the jury:

[*Pennoek & Sellers vs. Dialogue.*]

“ We are clearly of opinion that if an inventor makes his discovery public, looks on and permits others freely to use it, without objection or assertion of claim to the invention, of which the public might take notice; he abandons the inchoate right to the exclusive use of the invention, to which a patent would have entitled him, had it been applied for before such use. And we think it makes no difference in the principle, that the article so publicly used, and afterwards patented, was made by a particular individual, who did so by the private permission of the inventor. As long as an inventor keeps to himself the subject of his discovery, the public cannot be injured: and even if it be made public, but accompanied by an assertion of the inventor's claim to the discovery, those who should make or use the subject of the invention would at least be put upon their guard. But if the public, with the knowledge and the tacit consent of the inventor, is permitted to use the invention without opposition, it is a fraud upon the public afterwards to take out a patent. It is possible that the inventor may not have intended to give the benefit of his discovery to the public; and may have supposed that by giving permission to a particular individual to construct for others the thing patented, he could not be presumed to have done so. But it is not a question of intention, which is involved in the principle which we have laid down; but of legal inference, resulting from the conduct of the inventor, and affecting the interests of the public. It is for the jury to say, whether the evidence brings this case within the principle which has been stated. If it does, the court is of opinion that the plaintiffs are not entitled to a verdict.”

To this charge the plaintiffs excepted, and the jury gave a verdict for the defendant.

Mr Webster, for the plaintiff in error, contended,

1. That the invention, being of such a nature that the use of it, for the purpose of trying its utility and bringing it to perfection, must necessarily be open and public; the

[Pennock & Sellers vs. Dialogue.]

implication of a waiver or abandonment of the right, furnished by such public use, is rebutted by the circumstance that the article was made and sold only by one individual; and that individual was authorized and permitted so to do by the inventors..

2. That the use of an invention, however public, if it be by the permission and under the continual exclusive claim of the inventor; does not take away his right, except after an unreasonable lapse of time, or gross negligence, in applying for a patent.

3. That the jury should have been instructed, that, if they found the riveted hose, which was in use by the hose companies, had been all made and sold by Jenkins, and by no one else, prior to the grant of the patent; and that he was permitted by the inventors, under their agreement, so to make and sell the same; that such use of the invention, not being adverse to their claim, did not take away their exclusive right, nor imply an abandonment of it to the public.

4. That, if they found the hose had not been made or sold, prior to the grant of the patent, by any person but Jenkins, then the giving of permission to him, being in itself an assertion of claim, was not a dedication to the public; and that the public, by purchasing and using the hose, thus made by the permission of the inventors, acquired no title to the invention—but, on the contrary, if the price paid included a premium for the invention, the public by so purchasing, admitted the right of the inventors.

5. That, at any rate, there being no use, *by the public*, of this invention, it should have been left to the jury, to say, whether, under all the circumstances, considering the nature of the invention, and the time necessary to perfect it; the plaintiffs have been guilty of negligence, in not sooner applying for a patent.

Mr Webster stated, that the question to be decided by the Court laid within a narrow compass. The defence set up was, that the plaintiffs had suffered their invention to

[Pennock & Sellers vs. Dialogue.]

be used before their application for a patent; and had thus lost all right to the exclusive use of it.

The Court, in this case, would be called upon to reverse the English decision relative to abandonments; for it was admitted, that those cases had gone to the whole extent of the principles applied to this case in the circuit court. Those cases have decided, that any public use of an invention, even for experiment, renders it no longer a new machine. In the courts of the United States, a more just view had been taken of the rights of inventors. The laws of the United States were intended to protect those rights, and to confer benefits; while the provisions in the statute of England, under which patents are issued, are exceptions to the law prohibiting monopolies. Hence, the construction of the British statute had been exceedingly straight and narrow, and different from the more liberal interpretation of our laws.

By the decisions of our courts, there must be a *voluntary abandonment*, or *negligence*, or *unreasonable delay* in obtaining letters patent, to destroy the right of the patentee. *Goodyear vs. Mathews*, *Paine's Rep.* 300; *Morris vs. Huntington*, *Id.* 348.

The exception to the charge of the court is, that the jury should have been instructed to decide upon the evidence, whether the plaintiff meant to abandon his invention by the permission to Jenkins to use it. Jenkins must be considered as the private agent of the inventors; and their agreement with him, under which he made the hose, is to be considered rather as an assertion of their exclusive right to the invention, than a surrender of it. By omitting to leave to the jury this question of an intention to abandon, the case was erroneously withdrawn from them. The rights of the parties also entitled them to have the causes of their delay in patenting their invention inquired of by the jury. As the case is presented on the bill of exceptions, the court in their charge undertook to state the whole law of the subject matter to the jury; and the omission to instruct them on any one point is error.

[Pennock & Sellers vs. Dialogue.]

If in this charge of the court any thing is omitted which was matter of law for the jury, it is misdirection.

In a case in Massachusetts, said to be reported in 4th *Mason's Rep.*, it was left to the jury to decide whether seventeen years' delay could be accounted for.

Under the provisions of the laws of the United States, the right is created by the *invention*, and not by the *patent*. The court, therefore, may have misled the jury, in stating that the plaintiffs allowed the invention to be used. The *thing invented* was only permitted to be used.

The suggestion, that by adopting the language of the English statute, the cases decided in England upon that statute are adopted, may be answered by a reference to those cases. They have all arisen within a few years, since the enactment of our law; and, except the dictum of Lord Coke in 2d Institute, the authorities are all of modern date.

If this Court shall be of opinion, that as no instructions were particularly asked upon the questions raised here, the court below were not bound to notice them in the charge, and that the court did not undertake to decide the whole law; the plaintiff in error can make out no case here. But if this Court shall consider the questions now submitted doubtful, as the rights of the plaintiffs may not have been fully investigated; by sending the case back to the circuit court, a more full investigation of all the points involved in it may be made.

Mr Sergeant, for the defendant, insisted;

1. That mere invention gives no right to an exclusive use, unless a patent is obtained; and that if at a time when no right is infringed, the public fairly acquire possession of it, the inventor cannot, by subsequently obtaining a patent, take it away.
2. That the inventor, by abstaining from getting a patent encouraged the public to use the article freely, and thus benefited his own manufactory. And he is not at liberty, when this advantage is exhausted, to turn round, and en-

[Pennock & Sellers vs. Dialogue.]

deavour to reach another and a different kind of advantage, by appropriating the use exclusively to himself.

In the circuit where this cause was tried, it was not the practice to ask the court for special instructions to the jury. After the evidence had been closed, and counsel heard, a charge was given to the jury, according to the nature of the case, upon the points made by counsel, or which might suggest themselves to the mind of the judge. It was competent, however, to either party, after the charge, to ask the opinion of the court upon any point supposed to have been omitted, which was material to the decision. In this case, no such request had been made; and no objection can now be made to the charge, for any imputed omission. The only question was, whether the principles laid down to the jury for their guidance were correct, and according to law, in the particular excepted to.

The charge must of course be considered with reference to the facts, the whole of which appear upon the record. The petition of the plaintiffs to the secretary of state stated, in the words of the patent law, that they were the inventors of a "new and useful improvement," "not *known or used* before their application." The "application" was made in July 1818. Their averment therefore, upon which they obtained their patent was, that the rivet hose was a new invention, not "known or used" before the year 1818. The facts proved upon the trial were, that the invention had been completed and published in the year 1811, seven years before the application. That during all that period, it had been known and used as common public property, (and not as private property) which any one might use as publicly known. And that it was so known and used, with the knowledge of those who now claim to be the inventors; without any assertion or claim on their part of exclusive property, and without notice of intention to make such claim. There was not a single circumstance offered to explain the delay.

There was an attempt to show, that the making of the article for use, was limited by the authority and permission



[Pennock & Sellers vs. Dialogue.]

of the plaintiffs, and thence to infer that they did not intend to give it to the public. A witness, produced by them, and the only person who appeared to have made the article, declared in substance, "that he was taught by the plaintiffs in 1811 to make hose; that in *that* year he made a certain quantity of it for the Philadelphia Hose Company, plaintiffs being members of the committee; and that by permission of the plaintiffs he made about thirteen thousand feet of hose, for different hose companies, from 1811 to the time of granting the patent."

Thus, in point of fact, nearly two miles and a half in length of hose, had been made at different times in the course of seven years before the patent; and had been sold to different hose companies; not to experiment with, in order to bring the invention to perfection; but for public use, as a thing already completed, and adapted to the purpose of arresting the ravages of fire. It was so used; and from the year 1811 to the year 1818, it was never materially altered or improved. The thing patented in 1818 was precisely the thing invented, completed and used in 1811.

Were the plaintiffs, under these circumstances, entitled to a patent? or could a patent, thus obtained, be supported? The authorities upon the subject are decisive. He did not admit that the weight of judicial or legal opinion in England was lessened by the supposed difference in the policy of the two countries, or that in fact any such difference existed. It was true, that the process or mode of legislation was varied according to the existing state of things. The statute of James was made to abolish monopolies; but it saved, by exception, the rights of the inventors of new and useful inventions, who had before enjoyed exclusive privileges. The constitution of the United States and the act of congress; on the contrary, having no monopolies to deal with; created exclusive privileges in favour of the same description of persons. The one preserved to them a pre-existing monopoly, and the other conferred it upon them. Both were influenced by the merits of the inventor, and the public advantage of encouraging inventive genius. And they were

[Pennock & Sellers vs. Dialogue.]

equally influenced by these considerations; for it required at least as strong a sense of their just claims to distinction, to except new and useful inventions from the statutory odium and denunciation of monopolies, as it did to confer upon them the benefits of monopoly by direct enactment. There was no reason, therefore, why the judicial construction of the statute of James, (from which our act of congress was in this respect copied,) which had become, as it were, incorporated with and part of the statute, should not be as much respected as in the instance of any other statute. The adoption of the language of the statute, was the adoption also of its settled interpretation. It could not surely be insisted that England was wanting in intelligence to discern the value of genius, or in liberality to reward it; or that there was a prevailing bias in her judiciary towards an unjust restriction of the rights of meritorious inventors. The sentiment of the nation, and the government, in all its branches, was the opposite of this.

Before referring to the cases, it might be well, however, to examine the matter a little upon principle. What is the right of an inventor? It is the right, *given to him by the law*, to apply for and obtain a patent for his invention. The patent, when duly obtained, secures to him the exclusive enjoyment. Has he any other right before he obtains a patent than the one just stated? It is obvious that he has not. This, then, is what the learned judge, in his charge, styles, with peculiar aptness, an inchoate right; that is, a right to have a title upon complying with the terms and conditions of the law. It is like an inchoate right to land, or an inceptive right to land, well known in some of the states, and every where accompanied with the condition, that to be made available, it must be prosecuted with due diligence, to the consummation or completion of the title. If the condition be not complied with, the right is abandoned or lost, and the rights of others are let in. The abandonment is not a question of intention of the party, but it is the legal construction of his acts or omissions.

Had the plaintiffs ever such an inchoate right? Accord-

[Pennock &amp; Sellers vs. Dialogue.]

ing to the opinion of the judge, they undoubtedly had such a right by their invention in 1811. *Then*, they could have made out the case required by the first section of the act of congress—they could have stated with truth, that the thing invented “was not known or used before their application.” But in the year 1818 it was no longer true. It might be stated, but it could not be truly stated. They were unable to comply with the condition of law. For, if the inventor, as was the case here, voluntarily permit his invention to be known and used, as a thing not intended to be patented, how can he make this statement? By so doing, he abandons his inchoate right, he proclaims to the world that he does not mean to secure it by patent, and every one is at liberty to consider it abandoned; because every one acquainted with the law knows that he has incurred a disability. This is the inevitable legal construction of his conduct, and is altogether independent of his intention; unless we suppose the act to be guilty of the absurdity of requiring that to be stated which it does not require to be true.

But the terms of the act are in this respect too plain to admit of a doubt. Suppose an applicant should state, that his invention had been known and used for seven years before his application, could he obtain a patent? Suppose he should state, that he had always intended to reserve to himself a right to obtain a patent, would that help him? Or, if he should state that it had been so known and used only by his permission? The language of the act is plain and imperative. There is no scope for interpretation. The prescribed condition is express. And there is no doubt that it was the intention of congress to refer to the “application,” as the period before which the thing was not known or used; for in the subsequent act of 17th April 1800, conferring the privileges of the patent law upon resident aliens, the same word is used for the same purpose. And it is declared that the patent shall be void if the thing patented was *known or used before the application*. Act of 17th April 1800, section 1.

[Pennock & Sellers vs. Dialogue.]

It is not contended, that if the invention should be pirated, the use or knowledge, obtained by the piracy, or otherwise obtained without the knowledge or consent and without the fault of the inventor; would bar him from getting a patent. Nor is it contended that his own knowledge and use would be a bar. The latter is a necessary exception out of the generality of the terms of the law, because every inventor must know his invention, and must use it to the extent of ascertaining its usefulness, before he applies for a patent. The former is a case where there is no fault on the part of the inventor. But it is contended, that the inventor who means to rely upon a patent must make his application within a reasonable time; and that if he permit his invention to be publicly known and used before he applies, he cannot obtain a patent. He abandons his right, if he sell it for public use himself, and *a fortiori*, if he permit another so to sell it.

There is a cautious intimation in the charge, that possibly there might be some saving efficacy in accompanying the use with an assertion of claim by the inventor. And it is also put as a circumstance against the plaintiffs (which was clearly in evidence) that there was no such assertion or notice. The charge is therefore applicable only to a case of unqualified public use, without notice or assertion of claim. That such a notice would be available, or that there can be any other assertion of claim than the legal assertion by applying for a patent; are propositions which it is not now necessary to examine. They were not affirmatively laid down by the court, nor otherwise adverted to than for the purpose of showing that the facts did not entitle the plaintiffs to the benefit of them. They cannot therefore complain. Whether such assertions or notice, contradicted by the acts of the inventor, will be available, is a question not decided below. Certain it is, that a secret permission given to their own agent, can no more be an assertion or notice, than a resolution locked up in their own breasts.

The construction contended for is in accordance with the policy of the law. Patents are intended to be granted

[Pennoek & Sellers vs. Dialogue.]

for a limited time, beginning with the invention. He who asks for one must describe his invention with such certainty as will ensure to the public its use, when the patent expires; and at the expiration of the time, the thing invented is public property. The inventor, to enjoy its benefits, must place his whole reliance upon it. Is it competent for him, then, to secure to himself the advantages of his own peculiar knowledge and skill, as long as these will avail him, and when they are exhausted, to apply for a patent? There are many inventions, the secret of which is not at once discoverable from an inspection of the thing invented. The inventor may keep that as long as he can. He may have extraordinary skill or methods of working which will enable him to keep the market to himself. May he enjoy these exclusive privileges for seven years, and then obtain a patent for fourteen more? He would then have the exclusive use for twenty-one years. If for seven, why not for fourteen, or twenty-one, or any other assignable time? The moment that his invention comes into the most common or public use, is the moment when he applies for a patent. When the public have fully got possession of it, he seeks to withdraw it from the common stock and appropriate it to himself. This is directly contrary to the design of the law. It extends the term, and inverts the order of proceeding. The inconveniences would be very great. Those who were engaged in making the article must stop. Those who had arranged for making it must abandon their arrangements. Those who had employed their time in learning to make it must lose their time and their labour. And even a bona fide inventor, who had discovered the same thing by his own study and experiments, would be deprived of the fruits of his ingenuity and exertions. And why? Simply because the first inventor did not choose sooner to take out a patent, as he might have done. The conditions of the law being such as he can comply with, and ought to comply with; he postpones a compliance for his own profit, and leads the community into an injurious error. If it be de-

[Pennock & Sellers vs. Dialogue.]

signed, it is a wrong. If it be without design, it is negligence. Ought he to be benefited by his own wrong or negligence? The authorities are against him. He cited 3 *Inst.* 184; *Wood vs. Zimmer*, 1 *Holt's N. P. Rep.* 56; *Whittemore vs. Cutter*, 1 *Gall.* 482: and referred to *Evans vs. Eaton*, 1 *Peters's C. C. Rep.* 348; *Thompson vs. Haight*, 1 *U. S. Law Journal*, 563.

He then examined the several points stated for the defendant, contending that some of them were unsupported by the facts, and others by the law. Under the second he argued that there had been an "unreasonable lapse of time," and "gross negligence." That seven years (the period here) unexplained were beyond all reasonable bounds.

He contended, also, that due diligence, where there were no circumstances of explanation, was a question of law; and that it consisted in applying for a patent as soon, after the invention was completed, as could reasonably be done: and, finally, that due diligence required that the application should be made before the thing invented was publicly known and used with the consent of the inventor.

Mr Justice STORY delivered the opinion of the Court.

This is a writ of error to the circuit court of Pennsylvania. The original action was brought by the plaintiffs in error for an asserted violation of a patent, granted to them on the 6th of July 1818, for a new and useful improvement in the art of making leather tubes or hose, for conveying air, water, and other fluids. The cause was tried upon the general issue, and a verdict was found for the defendant, upon which judgment passed in his favour; and the correctness of that judgment is now in controversy before this court.

At the trial, a bill of exceptions was taken to an opinion delivered by the court, in the charge to the jury, as follows, viz. "That the law arising upon the case was, that if an inventor makes his discovery public, looks on and permits others freely to use it, without objection or assertion of claim to the invention, of which the public might take notice; he abandons

[Pennoek & Sellers *vs.* Dialogue.]

the inchoate right to the exclusive use of the invention, to which a patent would have entitled him had it been applied for before such use. And, that it makes no difference in the principle, that the article so publicly used, and afterwards patented, was made by a particular individual, who did so by the private permission of the inventor. And thereupon, did charge the jury, *that if the evidence brings the case within the principle which had been stated*, the court were of opinion that the plaintiffs were not entitled to a verdict."

The record contains, embodied in the bill of exceptions, the whole of the testimony and evidence offered at the trial, by each party, in support of the issue. It is very voluminous, and as no exception was taken to its competency, or sufficiency, either generally or for any particular purpose; it is not properly before this Court for consideration, and forms an expensive and unnecessary burthen upon the record. This Court has had occasion in many cases to express its regret, on account of irregular proceedings of this nature. There was not the slightest necessity of putting any portion of the evidence in this case upon the record, since the opinion of the court delivered to the jury, presented a general principle of law, and the application of the evidence to it was left to the jury.

In the argument at the bar, much reliance has been placed upon this evidence, by the counsel for both parties. It has been said on behalf of the defendants in error; that it called for other and explanatory directions from the court; and that the omission of the court to give them in the charge, furnishes a good ground for a reversal, as it would have furnished in the court below for a new trial. But it is no ground of reversal that the court below omitted to give directions to the jury upon any points of law which might arise in the cause, where it was not requested by either party at the trial. It is sufficient for us that the court has given no erroneous directions. If either party deems any point presented by the evidence to be omitted in the charge, it is competent for such party to require an opinion from the court upon that point. If he does not, it is a waiver of it.

[Pennock & Sellers vs. Dialogue.]

The court cannot be presumed to do more, in ordinary cases, than to express its opinion upon the questions which the parties themselves have raised at the trial.

On the other hand, the counsel for the defendant in error has endeavoured to extract from the same evidence, strong confirmations of the charge of the court. But, for the reason already suggested, the evidence must be laid out of the case, and all the reasoning founded on it falls.

The single question then is, whether the charge of the court was correct in point of law. It has not been, and indeed cannot be denied, that an inventor may abandon his invention, and surrender or dedicate it to the public. This inchoate right, thus once gone, cannot afterwards be resumed at his pleasure; for, where gifts are once made to the public in this way, they become absolute. Thus, if a man dedicates a way, or other easement to the public, it is supposed to carry with it a permanent right of user. The question which generally arises at trials, is a question of fact, rather than of law; whether the acts or acquiescence of the party furnish in the given case, satisfactory proof of an abandonment or dedication of the invention to the public. But when all the facts are given, there does not seem any reason why the court may not state the legal conclusion deducible from them. In this view of the matter, the only question would be, whether, upon general principles, the facts stated by the court would justify the conclusion.

In the case at bar; it is unnecessary to consider whether the facts stated in the charge of the court would, upon general principles, warrant the conclusion drawn by the court, independently of any statutory provisions; because, we are of opinion, that the proper answer depends upon the true exposition of the act of congress, under which the present patent was obtained. The constitution of the United States has declared, that congress shall have power "to promote the progress of science and useful arts, by securing *for limited times*, to authors and inventors, the exclusive right to their respective writings and discoveries." It contemplates, therefore, that this exclusive right shall exist but



[*Pennock & Sellers vs. Dialogue.*]

for a limited period, and that the period shall be subject to the discretion of congress. The patent act, of the 21st of February, 1793; ch. 11, prescribes the terms and conditions and manner of obtaining patents for inventions; and proof of a strict compliance with them lies at the foundation of the title acquired by the patentee. The first section provides, "that when any person or persons, being a citizen or citizens of the United States, shall allege that he or they have invented any new or useful art, machine, manufacture, or composition of matter, or any new or useful improvement on any art, machine, or composition of matter, *not known or used before the application*; and shall present a petition to the secretary of state, signifying a desire of obtaining an exclusive property in the same, and praying that a patent may be granted therefor; it shall and may be lawful for the said secretary of state, to cause letters patent to be made out in the name of the United States, bearing teste by the President of the United States, reciting the allegations and suggestions of the said petition, and giving a short description of the said invention or discovery, and thereupon, granting to the said petitioner, &c. *for a term not exceeding fourteen years*, the full and exclusive right and liberty of *making, constructing, using, and vending to others to be used*, the said invention or discovery, &c." The third section provides, "that every inventor, before he can receive a patent, shall swear, or affirm, that he does verily believe that he is the true inventor or discoverer of the art, machine, or improvement for which he solicits a patent." The sixth section provides that the defendant shall be permitted to give in defence, to any action brought against him for an infringement of the patent, among other things, "that the thing thus secured by patent was not originally discovered by the patentee, *but had been in use*, or had been described in some public work, *anterior to the supposed discovery of the patentee.*"

These are the only material clauses bearing upon the question now before the court; and upon the construction of them, there has been no inconsiderable diversity of

[Pénnock & Sellers vs. Dialogue.]

opinion entertained among the profession, in cases heretofore litigated.

It is obvious to the careful inquirer, that many of the provisions of our patent act are derived from the principles and practice which have prevailed in the construction of that of England. It is doubtless true, as has been suggested at the bar, that where English statutes, such for instance, as the statute of frauds, and the statute of limitations; have been adopted into our own legislation; the known and settled construction of those statutes by courts of law, has been considered as silently incorporated into the acts, or has been received with all the weight of authority. Strictly speaking, that is not the case in respect to the English statute of monopolies; which contains an exception on which the grants of patents for inventions have issued in that country. The language of that clause of the statute is not, as we shall presently see, identical with ours; but the construction of it adopted by the English courts, and the principles and practice which have long regulated the grants of their patents, as they must have been known and are tacitly referred to in some of the provisions of our own statute, afford materials to illustrate it.

By the very terms of the first section of our statute, the secretary of state is authorised to grant a patent to any citizen applying for the same, who shall allege that he has invented a new and useful art, machine, &c. &c. "*not known or used before the application?*" The authority is a limited one, and the party must bring himself within the terms, before he can derive any title to demand, or to hold a patent. What then is the true meaning of the words "*not known or used before the application?*" They cannot mean that the thing invented was not known or used before the application by the inventor himself, for that would be to prohibit him from the only means of obtaining a patent. The use, as well as the knowledge of his invention, must be indispensable to enable him to ascertain its competency to the end proposed, as well as to perfect its component parts. The words then, to have any rational interpretation, must

[*Pennock & Sellers vs. Dialogue.*]

mean, not known or used by others, before the application. But how known or used? If it were necessary, as it well might be, to employ others to assist in the original structure or use by the inventor himself; or if before his application for a patent his invention should be pirated by another, or used without his consent; it can scarcely be supposed, that the legislature had within its contemplation such knowledge or use.

We think, then, the true meaning must be, not known or used by the public, before the application. And, thus construed, there is much reason for the limitation thus imposed by the act. While one great object was, by holding out a reasonable reward to inventors, and giving them an exclusive right to their inventions for a limited period, to stimulate the efforts of genius; the main object was "to promote the progress of science and useful arts;" and this could be done best, by giving the public at large a right to make, construct, use, and vend the thing invented, at as early a period as possible; having a due regard to the rights of the inventor. If an inventor should be permitted to hold back from the knowledge of the public the secrets of his invention; if he should for a long period of years retain the monopoly, and make, and sell his invention publicly, and thus gather the whole profits of it, relying upon his superior skill and knowledge of the structure; and then, and then only, when the danger of competition should force him to secure the exclusive right, he should be allowed to take out a patent, and thus exclude the public from any farther use than what should be derived under it during his fourteen years; it would materially retard the progress of science and the useful arts, and give a premium to those who should be least prompt to communicate their discoveries.

A provision, therefore, that should withhold from an inventor the privilege of an exclusive right, unless he should, as early as he should allow the public use, put the public in possession of his secret, and commence the running of the period, that should limit that right; would not be deemed unreasonable. It might be expected to find a place in a

[Pennock &amp; Sellers vs. Dialogue.]

wise prospective legislation on such a subject. If it was already found in the jurisprudence of the mother country, and had not been considered inconvenient there; it would not be unnatural that it should find a place in our own.

Now, in point of fact, the statute of 21 Jac. ch. 3; commonly called the statute of monopolies, does contain exactly such a provision. That act, after prohibiting monopolies generally, contains, in the sixth section, an exception in favour of "letters patent and grants of privileges for *fourteen years or under*, of the sole working or making of any manner of new manufactures within this realm, to the true and first inventor and inventors of such manufactures, which *others, at the time of making such letters patent and grants, shall not use.*" Lord Coke, in his commentary upon this clause or proviso, (3 Inst. 184,) says that the letters patent "must be of such manufactures, which *any other at the time of making such letters patent did not use*; for albeit it were newly invented, yet if any other did use it at the making of the letters patent, or grant of the privilege, it is declared and enacted to be void by this act." The use here referred to has always been understood to be a public use, and not a private or surreptitious use in fraud of the inventor.

In the case of *Wood vs. Zimmer*, 1 *Holt's N. P. Rep.* 58, this doctrine was fully recognised by lord chief justice Gibbs. There the inventor had suffered the thing invented to be sold, and go into public use for four months before the grant of his patent; and it was held by the court, that on this account the patent was utterly void. Lord chief justice Gibbs said, "To entitle a man to a patent, the *invention* must be *new to the world*. The *public* sale of that which is afterwards made the subject of a patent, *though sold by the inventor only*, makes the patent void." By "invention," the learned judge undoubtedly meant, as the context abundantly shows, not the abstract discovery, but the *thing* invented; not the new secret principle, but the manufacture resulting from it.

The words of our statute are not identical with those of

[Pennock &amp; Sellers vs. Dialogue.]

the statute of James, but it can scarcely admit of doubt; that they must have been within the contemplation of those by whom it was framed; as well as the construction which had been put upon them by Lord Coke. But if there were no such illustrative comment, it is difficult to conceive how any other interpretation could fairly be put upon these words. We are not at liberty to reject words which are sensible in the place where they occur, merely because they may be thought, in some cases, to import a hardship, or tie up beneficial rights within very close limits. If an invention is used by the public, with the consent of the inventor, at the time of his application for a patent; how can the court say, that his case is, nevertheless, such as the act was intended to protect? If such a public use is not a use within the meaning of the statute, what other use is? If it be a use within the meaning of the statute, how can the court extract the case from its operation, and support a patent, where the suggestions of the patentee are not true, and the conditions on which alone the grant was authorised to be made, do not exist? In such a case, if the court could perceive no reason for the restrictions, the will of the legislature must still be obeyed. It cannot and ought not to be disregarded, where it plainly applies to the case. But if the restriction may be perceived to have a foundation in sound policy, and be an effectual means of accomplishing the legislative objects, by bringing inventions early into public and unrestricted use; and above all, if such policy has been avowed and acted upon in like cases in laws having similar objects; there is very urgent reason to suppose, that the act in those terms embodies the real legislative intent, and ought to receive that construction. It is not wholly insignificant in this point of view, that the first patent act passed by congress on this subject, (act of 1790, ch. 34, [ch. 7.]) which the present act repeals, uses the words "*not known or used before,*" without adding the words "*the application;*" and in connexion with the structure of the sentence in which they stand, might have been referred either to the time of the invention, or of the application. The addition of the

[Pennock & Sellers vs. Dialogue.]

latter words in the patent act of 1793, must, therefore, have been introduced, *ex industria*, and with the cautious intention to clear away a doubt, and fix the original and deliberate meaning of the legislature.

The act of the 17th of April 1800, ch. 25, which extends the privileges of the act of 1793 to inventors who are *aliens*; contains a proviso declaring, "that every patent which shall be obtained pursuant to the act for any invention, art or discovery, *which it shall afterwards appear had been known or used previous to such application for a patent*, shall be void." This proviso certainly certifies the construction of the act of 1793, already asserted; for there is not any reason to suppose, that the legislature intended to confer on *aliens*, privileges, essentially different from those belonging to *citizens*. On the contrary, the enacting clause of the act of 1800 purports to put both on the same footing; and the proviso seems added as a gloss or explanation of the original act.

The only real doubt which has arisen upon this exposition of the statute, has been created by the words of the sixth section already quoted. That section admits the party sued to give in his defence as a bar, that "the thing thus secured by patent was not originally discovered by the patentee, but had been in use *anterior to the supposed discovery* of the patentee." It has been asked, if the legislature intended to bar the party from a patent in consequence of a mere prior use, although he was the inventor; why were not the words "*anterior to the application*" substituted, instead of "*anterior to the supposed discovery*? If a mere use of the thing invented before the application were sufficient to bar the right, then, although the party may have been the first and true inventor, if another person, either innocently as a second inventor, or piratically, were to use it without the knowledge of the first inventor; his right would be gone. In respect to a use by piracy, it is not clear that any such fraudulent use is within the intent of the statute; and upon general principles it might well be held excluded. In respect to the case of a second invention, it is questionable

[Pennock & Sellers vs. Dialogue.]

at least, whether, if by such second invention a public use was already acquired, it could be deemed a case within the protection of the act. If the public were already in possession and common use of an invention fairly and without fraud, there might be sound reason for presuming, that the legislature did not intend to grant an exclusive right to any one to monopolize that which was already common. There would be no quid pro quo—no price for the exclusive right or monopoly conferred upon the inventor for fourteen years.

Be this as it may, it is certain that the sixth section is not necessarily repugnant to the construction which the words of the first section require and justify. The sixth section certainly does not enumerate all the defences which a party may make in a suit brought against him for violating a patent. One obvious omission is, where he uses it under a license or grant from the inventor. The sixth section in the clause under consideration, may well be deemed merely affirmative of what would be the result from the general principles of law applicable to other parts of the statute. It gives the right to the *first* and true inventor and to him only; if known or used before his supposed discovery he is not the *first*, although he may be a *true* inventor; and that is the case to which the clause looks. But it is not inconsistent with this doctrine, that although he is the *first*, as well as the *true* inventor, yet if he shall put it into public use, or sell it for public use before he applies for a patent, that this should furnish another bar to his claim. In this view an interpretation is given to every clause of the statute without introducing any inconsistency, or interfering with the ordinary meaning of its language. No public policy is overlooked; and no injury can ordinarily occur to the first inventor, which is not in some sort the result of his own laches or voluntary inaction.

It is admitted that the subject is not wholly free from difficulties; but upon most deliberate consideration we are all of opinion, that the true construction of the act is, that the first inventor cannot acquire a good title to a patent; if he suffers the thing invented to go into public use, or to be

[Pennock & Sellers vs. Dialogue.]

publicly sold for use, before he makes application for a patent. His voluntary act or acquiescence in the public sale and use is an abandonment of his right; or rather creates a disability to comply with the terms and conditions on which alone the secretary of state is authorized to grant him a patent.

The opinion of the circuit court was therefore perfectly correct; and the judgment is affirmed with costs.

This cause came on to be heard on the transcript of the record from the circuit court of the United States for the district of Pennsylvania, and was argued by counsel; on consideration whereof, it is the opinion of this Court, that there is no error in the judgment of the said circuit court. Whereupon, it is considered, ordered and adjudged by this Court, that the said judgment of the said circuit court in this cause, be and the same is hereby affirmed with costs.